

Application No. 10/050,346

-5-

REMARKS

Claims 1-9 and 21-24 remain in this application. Claims 10-20 have been cancelled. Claims 21 and 22 have been amended. Claims 1, 21 and 22 are independent claims.

A. Election/Restriction

In an Office action dated September 18, 2003, Applicants' previously filed remarks with regard to an election requirement were considered, but the requirement was deemed proper and therefore made final. Consequently, Applicants hereby cancel claims 10-20 as being drawn to the nonelected invention.

B. Amendments to Claims 21 and 22

Claim 21 was amended to include a colon after the preamble. The colon was inadvertently omitted.

Claim 22 has been amended to consistently refer to "textural features," rather than mistakenly alternating between reference to "textual" features and "textural" features.

Since the amendments to claims 21 and 22 merely correct errors, Applicants respectfully request that the amendments be entered.

C. Rejection under Section 102(e)

Claims 1-9 and 21-24 were rejected under 35 U.S.C. 102(e) as being anticipated by Tullis et al. In the September 18, 2003 Office action, it is correctly pointed out that the patent issued to Tullis et al. is "by another," since the inventors for the pending application are a subset of the inventors of the Tullis et al. patent. The Office action also noted that the rejection under 35 U.S.C. 102(e) can be overcome by showing under 37 CFR 1.132 that any

Application No. 10/050,346

-6-

invention disclosed but not claimed in the Tullis et al. patent was derived from the inventors of this pending application.

Submitted with this Amendment is the Declaration of Jun Gao under 37 CFR 1.132. The Declarant is a named inventor in the Tullis et al. patent and a named inventor within the pending application.

A first element of a proper showing under 37 CFR 1.132 is that the invention cannot be one that was claimed in the cited reference. For the pending application, each of the three independent claims (i.e., claims 1, 21 and 22) describes a method of classifying a medium of interest and includes using an input-output system/model in which textural features of the medium are used in the classification process. On the other hand, the claims of the Tullis et al. patent are directed to an invention in which droplets of print material (e.g., ink) are imaged. Thus, rather than imaging textural features, the Tullis et al. invention images droplets, although claim 24 of Tullis et al. refers to imaging "stealthy marks on a print medium." With regard to the purpose of imaging droplets or stealthy marks on a print medium, the claims refer to adjusting print quality on the basis of physical characteristics of the droplets. Thus, media classification is not claimed in the Tullis et al. patent.

Another element of a proper showing under 37 CFR 1.132 is that the evidence upon which an applicant relies must predate the effective date of the cited reference. The relevant date of the Tullis et al. patent is the filing date of March 27, 2001. All of the dates contained within Exhibit A of the Declaration are prior to this date. On page 1 of Exhibit A, the date of reception of the Invention Disclosure at HP Legal Department is identified as February 20, 2001. On page 2 of the Invention Disclosure, the witness (Carl Picciotto) is shown as having a "Date of Signature" of February 7, 2001. On each of the final eleven pages of Exhibit A, the signatures of the two identified inventors and the signatures of two witnesses all predate the filing date for the Tullis et al. patent. For example, the signature date for the "witness signatur " of Carl Picciotto matches that of his witness signature on page 2 of Exhibit A.

Application No. 10/050,346

-7-

As the third element of a proper showing under 37 CFR 1.132, the evidence that is presented must show that the invention which was disclosed but not claimed in the Tullis et al. patent was derived from the inventors of the pending application, so that the invention is not "by another." As previously noted, Applicants' pending claims are directed to (1) media classification, (2) using a probabilistic input-output system/model, and (3) detection of textural features of the medium of interest. The interaction of these three components is described in detail in the Invention Disclosure of Exhibit A of the Declaration. The embodiment of the input-output system/model that is described in detail is the cluster-weighted model. The Invention Disclosure provided the basis for the invention claimed in the pending claims, as evidenced by the correlation between the Attorney Docket No. of the pending application and the docket number found in the upper left hand area of Exhibit A (i.e., 10012641). Moreover, the sequence of fourteen equations starting on page 4 of Exhibit A is also found in the pending application, starting with Eq. 2 on page 6 of the pending application.

It is respectfully submitted that the only portion of the Tullis et al. patent that describes discriminating media into classes is the portion that begins on line 62 of column 11 and ends on line 13 of column 12. The patent states that the "dot sensor" that is used to image the dots (droplets) on the print media has sufficient resolution to distinguish texture within the images of the medium surface. In the Declaration of Jun Gao, it is directly stated in Paragraph 10 that the portion of the Tullis et al. patent that describes using information of textural features of print media as input parameters for a probabilistic input-output model in order to classify the print media is derived from the work of the two co-inventors of the pending application. Thus, neither Barclay Tullis nor Carl Picciotto, who were co-inventors in the Tullis et al. patent, were co-inventors of the media-discrimination invention described in columns 11 and 12 of the Tullis et al. patent. This conclusion is supported by the fact that Carl Picciotto signed the Invention Disclosure of Exhibit A as a witness to whom the invention was explained, as shown on page 2 of Exhibit A.

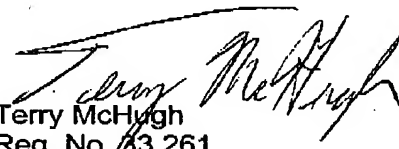
Application No. 10/050,346

-8-

Applicants respectfully submit that the Declaration under 37 CFR 1.132 and its accompanying Exhibit A establish that the invention which was described but not claimed in the Tullis et al. patent was derived from the work of the inventors of the pending application. Applicants respectfully request reconsideration of the claims in view of the amendments, Declaration, and remarks made herein. A notice of allowance is earnestly solicited. In the case that any issues regarding this application can be resolved expeditiously via a telephone conversation, Applicants invite the Examiner to call Terry McHugh at (650) 969-8458.

Respectfully submitted,

Date: November 18, 2003



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